

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In reply to the Office Action mailed August 4, 2008 (the "Outstanding Office Action"), Applicant respectfully requests a panel review of the rejections under 35 U.S.C. § 103(a) discussed in the remarks below. No amendments are being filed with this Request. This Request is being filed concurrently with a Notice of Appeal. Although the rejection is not a final rejection, this appeal action is proper under 35 U.S.C. § 134 as the claims at issue have been twice rejected. See also MPEP 1204(I).

Claims 51-55, 57-59, 63, 65, 66, 69-72, and 74-78 have been rejected in the Outstanding Office Action under 35 U.S.C. § 103(a) as being unpatentable over WO 00/74734 to Watling (“Watling”) in view of U.S. Patent No. 6,630,105 to O’Neill et al. (“O’Neill”). Claims 56, 60, 64, 67 and 68 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watling* and *O’Neill* and further in view of various other references: claim 56 is rejected in view of U.S. Patent No. 6,589,479 to Dufresne et al. (“Dufresne”); claim 60 is rejected in view of UK Patent

Application No. GB 2 360 454 A to Martin (“*Martin*”), and claims 64, 67 and 68 under 35 USC § 103(a) are rejected in view of U.S. Patent No. 5,173,258 to Childers (“*Childers*”).

Applicant notes that all of the rejected claims 51-60, 63-72, and 74-78 rely on the allegedly obvious combination of *Watling* and *O’Neill*. Of the rejected claims, claims 51 and 70 are independent claims.

A. Background

In response to a restriction requirement set forth by the Examiner on February 26, 2007, the Applicant added new independent claims 51 and 70 directed to methods of decontaminating an enclosed space in which the decontaminant condenses onto the surfaces of the enclosed space.

Claim 51 was directed to a method of decontaminating an enclosed space comprising steps of “creating a recirculating heated airstream within an enclosed space,” and “progressively introducing hydrogen peroxide/water vapour into the recirculating heated airstream until the atmosphere within the enclosed space reaches a dew point that causes the hydrogen peroxide/water vapour within the atmosphere to condense onto surfaces bounding or within the enclosed space;” claim 70 was directed to a method of decontaminating an enclosed space comprising activating and operating a portable decontamination apparatus while it is positioned within the enclosed space.

In a subsequent Office Action mailed July 12, 2007 (the “First Office Action”), the Examiner rejected independent claim 51 as being anticipated by *Watling* and independent claim 70 as being obvious over *Watling* in view of *O’Neill*. Regarding the obviousness rejection of claim 70, the Examiner conceded that “*Watling* does not appear to disclose that the device is intended to be portable from one place to another or located inside the enclosed space.” *First Office Action at page 8*. The Examiner then pointed to *O’Neill* to cure this deficiency of *Watling*, asserting that *O’Neill* discloses a decontamination method that “is portable and positioned within the enclosed space in order to allow the device to be readily transported from one enclosed space to another.” *First Office Action at page 8*. The Examiner concluded that “[i]t would have been obvious ... to modify the method of *Watling* to make the method more readily portable in order to allow the device to be readily transported from one enclosed space to another as exemplified by *O’Neill*.” *First Office Action at pages 8-9*.

In response to the First Office Action, Applicant filed a response on October 11, 2007 (“*Applicant’s First Response*”), in which claim 51 was amended to recite that both of the claimed

steps are “performed by an apparatus that is disposed within the enclosed space.” *See page 2.* Applicant also presented arguments as to why it would not have been obvious to combine the *Watling* and *O’Neill* references. For example, Applicant argued that because *Watling* specifically teaches coating all of the surfaces of a sealed enclosure with a layer of decontaminant condensate and because *O’Neill* specifically teaches against forming a condensate of the decontaminant on any surface, *O’Neill* teaches away from the purportedly obvious combination. *See Applicant’s First Response, pp. 11-12.* Applicant argued that as a result, a *prima facie* case of obviousness had not been established by the Examiner according to MPEP 2145(X)(D)(2).

In the ensuing Office Action mailed December 21, 2007, (the “Second Office Action”), the Examiner maintained his obviousness rejection of claim 70 and also rejected claim 51 based on the same *Watling/O’Neill* combination. The Examiner asserted, similar to the First Office Action, that “it would have been obvious … to modify the method of *Watling* to produce the process steps from a portable device that is located inside the enclosure in order to allow the device to be readily transported from one enclosed space to another as exemplified by *O’Neill*.” *Second Office Action at page 3.* The Examiner further asserted that Applicant’s argument against combining *Watling* and *O’Neill* presented in Applicant’s First Response was not persuasive because “*O’Neill* is merely relied upon to provide motivation for one of ordinary skill in the art to make the gas generating apparatus of *Watling* portable.” *Second Office Action at page 12.* In other words, it appears that the Examiner was maintaining that because *O’Neill* shows a portable decontamination system, a finding of obviousness is justified regardless of what the rest of *O’Neill* teaches.

In response to the Second Office Action, Applicant filed another response on May 21, 2008 (“*Applicant’s Second Response*”). Applicant further discussed the differences between *Watling* and *O’Neill* and presented various arguments countering the assertions of the Examiner. For example, Applicant reiterated in more detail how *Watling* is directed to sterilizing by forming a layer of condensate on the surfaces of the sealed enclosure while *O’Neill* teaches against using a condensate. *See Applicant’s Second Response, pp. 9-10.* Other major differences between *Watling* and *O’Neill* that would preclude a finding of obviousness were also presented. For example, Applicant discussed how, due to the design and portability of *O’Neill*, the *O’Neill* apparatus would not be able to uniformly saturate all the surfaces of a sealed enclosure with a gas, let alone a condensate, as is done in *Watling*. *See Applicant’s Second Response, pp. 10-11.*

Applicant also discussed how because *Watling* is designed for a stationary sealed enclosure there is no need to make the preparation region of *Watling* portable. *See Applicant's Second Response*, pp. 11-12. Other arguments against combining *Watling* and *O'Neill* were also presented.

B. Legal and Factual Deficiencies

In the Outstanding Office Action, the Examiner has once again failed to consider the prior art references in their entirety.

As discussed above, the Applicant has presented various arguments in the First and Second Responses as to why one would not find it obvious to combine the *Watling* and *O'Neill* references. Instead of considering those arguments, the Examiner has simply maintained that “*O'Neill* is merely relied upon to disclose a portable decontamination system and its advantages of decontaminating enclosures at various locations.” *See Outstanding Office Action at page 12*. In other words, the Examiner has once again simply chosen to ignore all of the portions of *O'Neill* except those that show portability. Applicant submits that in so doing, the Examiner has committed clear error.

According to established law, when considering any prior art reference, “[the] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” MPEP 2141.01(VI), citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). However, the Examiner has failed to do this. As discussed above, Applicant has presented a variety of arguments in Applicant’s First and Second Responses evidencing why it would not have been obvious to combine *Watling* and *O'Neill* and why one of skill in the art would not find it obvious to arrive at the claimed invention therefrom. Those arguments include evidences that *O'Neill* teaches away from such a combination, that *Watling* would not work as designed if combined with *O'Neill*, and that there is no need for the *Watling* apparatus to be made portable. Instead of answering the substance of the applicant’s arguments, the Examiner has once again maintained in the Outstanding Office Action that “*O'Neill* is merely relied upon to disclose a portable decontamination system and its advantages of decontaminating enclosures at various locations.” Thus the Examiner has failed to consider *O'Neill* in its entirety contrary to established law.

C. Conclusion

In light of the discussion set forth herein, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 51-60, 63-72, and 74-78, at least because the Examiner has failed to consider the prior art in its entirety, and by so doing has failed to counter applicant's arguments as set forth in Applicant's First and Second Responses showing that the references teach away from the allegedly obvious combination and that the Watling apparatus would not work as designed.

Because the rejections set forth in the Outstanding Office Action include legal and factual deficiencies, Applicant is entitled to a pre-appeal brief review of the Outstanding Office Action. Moreover, in view of the foregoing remarks, Applicant submits that the Examiner has committed clear error in rejecting the pending claims and respectfully requests withdrawal of the rejections, reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Dated this 4th day of December, 2008

Respectfully submitted,

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